

**REMARKS / ARGUMENTS**

Claims 1-20 have been rejected by the Examiner and are pending in this application. The outstanding issues in the present Office Action are:

- Claims 1-5, 11-13, 16 and 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over alleged applicant admitted prior art; and
- Claims 6-10, 14-15 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over alleged applicant admitted prior art in view of *SQL ServerälTransact-SQL User's Guide*.

In response, Applicants respectfully traverse the outstanding rejections and request reconsideration and withdrawal thereof in light of the remarks presented herein.

**I. Rejections Under 35 U.S.C. § 103(a)**

To establish a *prima facie* case of obviousness, three basic requirements must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the applied reference cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding any of the three requirements, Applicants assert that, at the least, the rejection does not satisfy the first and third requirements.

**A. Independent Claims 1, 13 and 18**

**1. Prior Art Does not Teach or Suggest All Claim Limitations**

The Examiner asserts that independent claims 1, 13, and 18 are unpatentable over applicant admitted prior art. Applicants respectfully traverse as detailed below.

Claim 1 recites, *inter alia*:

A method of reporting existence of a specified condition in a system attribute, said method comprising:  
receiving a request from a client to notify said client of a

condition of an attribute of a system...

upon determining that said condition exists, notifying said client of the existence of said condition. (emphasis added)

Additionally, claim 13 recites, *inter alia*:

A reporting application for reporting the existence of a specified condition in a system attribute to a client, said reporting application comprising:

computer executable software code for receiving from a client a request to notify said client...

computer executable software code that, upon determining that said condition exists, notifies said client of the existence of said condition. (emphasis added)

Claim 18 recites, *inter alia*:

A system for reporting the existence of a specified condition in a system attribute to a client, said system comprising:

means for storing a reporting application...

wherein said reporting application includes computer executable software code for receiving from a client a request to notify said client of a condition of an attribute of a system...

and computer executable software code that, upon determining that said condition exists, notifies said client of the existence of said condition. (emphasis added)

In rejecting claims 1, 13 and 18 the Examiner asserts that the applicant admitted prior art teaches “receiving a request from a client to notify said client of a condition.” See Office Action at page 3. In support of this assertion, the Examiner cites the present Application at page 2, lines 1-5 and page 3, lines 21-23.

Page 2, lines 1-5 states in part,

“...a prior art application program may operate to investigate and obtain information about system attributes, and then such program may itself figure out whether any changes have occurred...”

Similarly, page 3, lines 21-23 states, “...in the prior art, an application program can issue commands querying the system, and in response to such commands receive ‘actual’ data.”

Nowhere in the cited text is there an indication of a reporting application methodology that receives a request from a client to notify the client of a condition. Rather, in the prior art described by the present application, the client itself (e.g. the application program in the above-quoted portions) performs queries, receives actual data responsive to such queries, and derives the desired data from the received actual data. Thus, the applied reference described by the present application does not include a reporting application for receiving from a client a request to notify the client of a condition of an attribute. Therefore, the described prior art fails to teach “receiving a request from a client to notify said client” (as recited by claim 1) or “receiving from a client a request to notify said client” (as recited by claims 13 and 18).

A clearly illustrative example of the prior art described by the present application at page 4, lines 15-28, recites as follows:

As a further example, suppose that an application of the prior art desires to keep track of the nodes within a cluster that contains nodes 1, 2, 3, 4 and 5. Further suppose that the application first issues a command that queries the cluster for its status and membership, and responsive to such command is returned information indicating that nodes 1, 2, 3 and 5 are contained in the cluster. From such information, the application program can execute to determine that node 4 has been removed from the cluster. At a later point in time, the program issues another command that queries the cluster for its status and membership, and responsive to such command is returned information indicating that nodes 1, 3, 4 and 5 are contained in the cluster. From such information, the application program can execute to determine that node 4 has returned (been added back to the cluster) and node 2 has been removed from the cluster. Thus, from the information received in response to the application's query, the application can “derive” that node 4 has been added to the cluster and node 2 has been removed.

As provided in the above example, an application program (or client) of the prior art may itself query a cluster, receive actual data identifying member nodes of the cluster, and derive information (e.g. whether node 4 has been removed from the cluster) from the actual data. Again, as this example further illustrates, the described prior art fails to provide a reporting application for receiving from a client a request to notify the client of a condition of an attribute. As a result, the applied reference does not teach the above-stated limitations of claims 1, 13 and 18 of the present application. Accordingly, because the prior art described

in the present application does not teach at least the above-identified elements of claims 1, 13 and 18, those claims are not obvious in view of the described prior art.

Further, the Office Action admits that the prior art does not teach “deriving data about said system attribute to determine if said condition exists.” See Office Action at page 3. The Office Action attempts to cure this deficiency by referencing page 2, lines 1-5, which state: “[the] application program may itself figure out whether any changes have occurred in the system attributes, so that the program may account for any such changes” (emphasis added). The Examiner cites the referenced text as indicating that the described prior art is capable of “deriving data about said system attribute to determine if said condition exists” (as recited by Claim 1).

However, Applicants respectfully contend that the Office Action’s assertion conflates the responsibilities of the application program and the reporting application, when comparing the described prior art with the present application. For instance, as detailed above in the described prior art, the application program issues commands to retrieve actual data regarding the status and membership of a cluster. Then the application program sorts through the received data to determine whether any changes have occurred within the cluster. See Application at page 3, lines 15-18. Thus, in this case, the client (e.g., the application program) itself is responsible for querying the system and deriving desired information from the received actual data. The described prior art fails to teach a “method of reporting existence of a...condition...comprising...deriving data about said system attribute...” (as recited by claim 1) or “[a] reporting application...comprising...computer executable software code for deriving data about said system attributes...” (as recited by claim 13). Since the described prior art requires that the application program itself perform the task of figuring out whether any changes in conditions have occurred, the applied reference fails to teach at least the above limitations of claims 1 and 13. Therefore, claims 1 and 13 are not obvious in view of the described prior art.

Additionally, the Office Action admits that the prior art does not teach a system capable of determining if said condition exists; and upon determining that said condition exists, notifying said client of the existence of said condition. See Office Action at page 4. The Office Action attempts to cure this deficiency by referring to page 2, lines 2-6 of the

Application, which states in part, “application program...may itself figure out whether any changes in the conditions have occurred...so that the system may account for any such changes.” (emphasis added). The Office Action alleges that the referenced text exemplifies that the prior art teaches a method for determining the existence of a condition. However, claim 18 of the present application recites “[a] system for reporting...wherein said reporting application includes computer...code for receiving from a client a request to notify said client of a condition” (emphasis added). It follows that the described prior art does not teach the limitation of claim 18, as the described prior art details a method wherein the application program “figure[s] out whether any changes have...occurred”, as opposed to a reporting application receiving a request to notify the client of a condition. Therefore, the described prior art fails to teach the limitations of claim 18, and hence, claim 18 is not obvious in view of the described prior art.

In view of the above, Applicants respectfully submit that independent claims 1, 13 and 18 are not obvious over the applied reference.

## 2. Lack of Motivation

It is well settled that sufficient motivation must be provided to establish a prima facie case of obviousness. See M.P.E.P. § 2143. In the present Office Action, the Examiner fails to state a motivation for modifying the existing prior art in the manner necessary to achieve the claims of the present application. Rather, the Examiner makes the following conclusory statement:

“Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the applicant admitted prior art by combining the steps of receiving request, querying system, deriving data, determining condition exist and notifying the client in order to stimulate notification regarding changes of system attributes.” See Office Action at page 4.

Such language is merely a statement that the reference can be modified and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01 (citing, *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990)). Thus, the 35 U.S.C. § 103(a) rejection

made by the Examiner is improper, as the Examiner's rejection must set forth motivation that establishes the desirability for making the modification.

**B. Dependent Claims 2 – 12, 14 – 17 and 19 – 20**

Claims 2-12, 14-17, and 19-20 each depend either directly or indirectly from one of base claims 1, 13, and 18, and thus inherit all limitations of their respective base claims. It is respectfully submitted that the dependent claims are allowable not only because of their dependency from their respective base claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the base claims from which they depend).

The Office Action admits that the prior art does not teach the method wherein “[the] client is a graphical user interface (GUI) that displays information to a human user,” as detailed in independent claim 11 of the present invention. (See Office Action at page 6). In addition, the Office Action admits that the prior art does not teach the limitations of dependent claim 12, which include “deriving data to determine if a condition of said one or more attributes exists such that the GUI should redraw the graphics displaying said information about said one or more attributes.” (See Office Action at page 7). The Office Action attempts to cure these deficiencies by referencing the Application at page 5, lines 28-29, which states, “[i]n the prior art, an application or user may be notified asynchronously of changes in system attributes.”

The Examiner cites the referenced text as indicating that the prior art contained a methodology “wherein the client is a GUI that displays information to a human user” as detailed in claim 11. The Examiner also cites the referenced text to support his assertion that the prior art contains the methodology detailed in claim 12.

However, Applicants respectfully contend that the Office Action's assertion conflates the responsibilities of the application program and the reporting application, when comparing the prior art with claims 11 and 12 of the present application.

While Applicants admit GUI interfaces are well known in the prior art for displaying information to a human user, Applicants respectfully submit that applications of the prior art do not comprise a GUI interface as recited by claims 11 and 12 of the present application.

An example of the described prior art is provided in the present application at page 5, line 28 through page 6, line 4, which provides:

[A] user may be notified if a printer on the system is out of ink, has a paper jam, or is out of paper. However, as explained above, if an application or user desires derived data, such as whether all printers existing on a network or within a cluster are out of paper, the user or application itself is required to derive such data from actual data received from querying the network or cluster. (emphasis added) See Application at page 5, line 28 through page 6, line 4.

Claim 1, from which claims 11 and 12 each depend (either directly or indirectly), recites, *inter alia*, "receiving a request from a client to notify said client of a condition of an attribute of a system" (emphasis added). As described above, the described prior art fails to teach receiving such a request from a client, as the client itself performs a query of the system and derives data to determine whether a condition of an attribute exists. Further, the described prior art certainly fails to teach such a limitation wherein the recited client is a GUI, as in claims 11 and 12. Therefore, Applicants respectfully submit that dependent claims 11 and 12 are not obvious under 35 U.S.C. §103(a) over the described prior art.

#### CONCLUSION

Claims 1-20 are pending in the current application. No claims have been amended herein. As shown above, there are important differences between the claims and the applied art. Moreover, a person of ordinary skill in the art considering the prior art would not find these differences obvious. Accordingly, Applicants respectfully assert that claims 1-20 are allowable over the applied art. Therefore, Applicants respectfully request that these claims be passed to issue.

Applicants respectfully request that the Examiner call the below listed attorney if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit: July 24, 2002

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